



# UNITED STATES PATENT AND TRADEMARK OFFICE

4/L  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,960	11/21/2000	Michael Brines	10165-009-999	6595
20583	7590	09/16/2004	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			DEBERRY, REGINA M	
			ART UNIT	PAPER NUMBER
			1647	
DATE MAILED: 09/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/716,960	<b>Applicant(s)</b> BRINES ET AL.	
	<b>Examiner</b> Regina M. DeBerry	<b>Art Unit</b> 1647	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 July 2004 has been entered.

***Information Disclosure Statement***

The information disclosure statement (IDS) filed 26 July 2004 was received and complies with the provisions of 37 CFR §§1.97 and 1.98. It has been placed in the application file and the information referred to therein has been considered as to the merits.

***Status of Application, Amendments and/or Claims***

The amendment filed 24 December 2003 has been entered in full. New claims 10-13 were added. Claims 1-6, 8-13 are under examination.

***Claim Rejections - 35 USC § 112, first paragraph, scope of enablement***

Claims 1-6, 8-13 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for:

a method for protection of an excitable tissue comprising administering a non-toxic amount of EPO peripherally to a mammal suffering from a neurodegenerative condition

does not reasonably provide enablement for:

a method for the *treatment of a neurodegenerative condition* comprising administering peripherally to a mammal an effective non-toxic amount of EPO for the protection of an excitable tissue.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The basis for this rejection is set forth at pages 2-5 of the previous Office Action (25 July 2003).

Applicant argues that the new claims are enabled by the instant application. Applicant cites pages in the instant specification as evidence of enablement.

Applicant's arguments have been fully considered but not deemed persuasive. The specification is not enabled for a method for the treatment of a neurodegenerative condition comprising administering peripherally to a mammal an effective non-toxic amount of EPO for the protection of an excitable tissue. The subject matter sought to be patented as defined by the claims (treatment of neurodegenerative conditions) is not supported by an enabling disclosure. Neurodegenerative diseases are a varied assortment of central nervous system disorders characterized by gradual and progressive loss of neural tissue. Neurodegenerative conditions encompass diseases such as Alzheimer's disease, Parkinson's disease, Huntington disease, multiple

Art Unit: 1647

sclerosis. The specification is not enabled for the treatment of the broad class of neurodegenerative conditions.

The examples disclosed in the instant specification, demonstrated "some protection of excitable tissue" upon peripherally administering EPO, but these results are not correlative with "treatment of a neurodegenerative condition". The scientific reasoning and evidence as a whole indicates that the rejection should be maintained.

***Conclusion***

No claims are allowed.

Art Unit: 1647

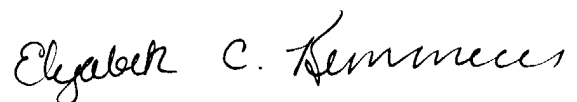
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina M. DeBerry whose telephone number is (571) 272-0882. The examiner can normally be reached on 9:00 a.m.-6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda G. Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



RMD  
9/8/04



ELIZABETH KEMMEYER  
PRIMARY EXAMINER